

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tumay O. Tumer

Application No.: 09/396,352

Group No.: 2612

Filed: 09/14/1999

Examiner: Lee, Benjamin C

For: Tag Having a Semiconductor Chip and Method of Attachment to Article

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1. Transmitted herewith, is the REPLY BRIEF in this application, with respect to the Examiner's Answer filed on July 20, 2006.
2. The REPLY BRIEF was originally filed on September 19, 2006 however the filing date was listed as the application number and therefore the REPLY BRIEF never reached the correct application.
3. FEE PAYMENT

Fee was already submitted with the original filing of the Appeal Brief on May 30, 2006.

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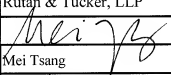
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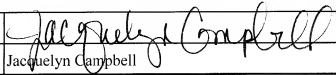
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	First Named Inventor	Tumay O. Tumer
	Art Unit	2612
	Examiner Name	Lee, Benjamin C
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 3611**

EXAMINER: Lee, Benjamin C
APPELLANT: Tumer, Tumay O
SERIAL NO. 09/141,999 09/390 352
FILED: September 14, 1999
FOR: Tag Having a Semiconductor Chip and Method of Attachment to Article
ART UNIT 2612

MS Appeal Brief - Patents
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Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

REPLY BRIEF UNDER 37 CFR § 1.193

This brief follows the Examiner's Answer, which has been mailed July 20, 2006.

REPLY POINTS TO THE EXAMINER'S ANSWER

In his reply to the Appellant's brief, it appears that the Examiner continues to misconstrue and incorrectly identify various terms of the cited references and further continues to rely on impermissible hindsight to reconstruct the invention. The appellant's reply to the Examiner's answer is given in more detail below.

U.S.C. § 103(a)

Claims 75-76, 78-81, 83-84, 90-96 and 100 were rejected under 35 U.S.C. § 103(a) as being obvious over Kip et al. (U.S. Pat. No. 5,105,190) in view of Carroll (U.S. Pat. No. 4,857,893). (Examiner's Answer, pages 3-7).

Claims 27-28, 33-44, 48-52, 54-64, 68-74, 77, 85-88, 102-103 and 107-109 were rejected under 35 U.S.C. § 103(a) as being obvious over Kip in view of Moskowitz et al. (U.S. Pat. No. 5,528,222) and Carroll (U.S. Pat. No. 4,857,893) (Examiner's Answer, pages 7-14).

Claim 101 under 35 U.S.C. § 103(a) was rejected as being obvious over Kip in view of Carroll and Tuttle et al. (U.S. Pat. No. 5,779,839) (Examiner's Answer, page 14).

Claims 104-106 under 35 U.S.C. § 103(a) were rejected as being obvious over Kip in view of Moskowitz, Carroll and Tuttle (Examiner's Answer, page 14).

Claim 97 under 35 U.S.C. § 103(a) as being obvious over Kip in view of Carroll and Roth et al. (U.S. Pat. No. 5,272,117) (Examiner's Answer, page 14).

Claims 45 and 65 were rejected under 35 U.S.C. § 103(a) as being obvious over Kip in view of Moskowitz, Carroll and Roth (Examiner's Answer, page 15).

Claims 46-47 and 66-67 were rejected under 35 U.S.C. § 103(a) as being obvious over Kip in view of Moskowitz, Carroll and further in view of Schoenian et al. (U.S. Pat. No. 5,748,106) (Examiner's Answer, page 15).

Claims 98-99 were rejected under 35 U.S.C. § 103(a) as being obvious over Kip and Carroll and further in view of Schoenian (Final Office action, page 16).

Claim 82 was rejected under 35 U.S.C. § 103(a) as being obvious over Kip in view of Moskowitz and Carroll and further in view of Carney et al. (U.S. Pat. No. 5,446,447) (Final Office action, page 17).

Claim 89 was rejected under 35 U.S.C. § 103(a) as being obvious over Kip, Moskowitz and Carroll in view of Lake (U.S. Pat. No. 6,031,459) (Final Office action, page 18).

Misconstruction of Terms in Carroll

In his reply, the Examiner identifies Kip et al. disclosing the claimed tag comprising a circuit that include elements of claim 75 expect “specifying the claimed invention wherein the circuit is in the form of an integrated circuit.” and that Carroll teaches “all circuit components of a tag are implied in the form of an integrated circuit located on a die...”and refers in this context to Figs 9A-9B and col. 11, line 11 to col. 12, line 51). ***Respectfully, the Examiner incorrectly cites Carroll by reciting elements that Carroll does not disclose or teach.*** The only thing Carroll teaches in that passage is that the a transponder device can include “...its receiving and transmitting antenna coil and *power circuits...*” and “...may be realized on a single semiconductor chip...”. (emphasis added). (See Carroll, col. 3, lines 28-31). It does not, however, disclose or teach a *power storage component* as recited in claim 75. A power circuit disclosed in Carroll is not the same as a power storage component disclosed in claim 75.

Specifically, Carroll teaches putting a battery on the outside of the chip and having the power circuit on the chip for integration, but not the battery that is the power supply. (See Carroll, col 10, lines 32-52). Unlike the present claimed subject matter, Carroll’s power circuit will not work unless a battery is connected. The battery in Carroll can be physically under, on top, or on the side of the chip. (See Carroll, fig. 7). Carroll does not, however, teaches or suggests a power supply integrated as part of the chip.

On the other hand, the power storage component as recited in claim 75 functions as a power supply that receives and stores sufficient energy to power the integrated circuit. The present application uses an integrated power storage component that sends electromagnetic waves to the chip, where the chip receives them through an antenna and send the charge received through circuitry onto a capacitor or a capacitor bank (parallel capacitors) and charge up the capacitors.

The main advantage here is that the charged power storage component stored in the capacitors are then used to power the circuit. (See spec, figs. 9 and 11, page 8, lines 8-10, page 16, lines 21 and page 48, lines 17-20). Thus, the Examiner respectfully fails to identify any teaching, suggestion, or motivation in the prior to combine the references in a manner that would satisfy all of the elements of the pending claims.

Hindsight Using Carroll

The assertion by the Examiner that “It would have been obvious to one of the ordinary skill in the art at the time of the claimed invention to implement the tag circuit of Kip in an integrated circuit form as taught by Carroll for mass production such as cost, and compact housing for ease of physical application in intended uses”, is based on incorrect assertions and further relying on hindsight. There is absolutely no teaching, suggestion or motivation in the Kip reference to (1) implement a tag in the form of an integrated circuit, and then (2) to have a sufficient power supply that provides sufficient energy to operate the tag.

Once again, the appellant points out the rejections on obviousness would still be inappropriate because one of ordinary skill in the art would have expected the claimed combination to fail. ***The reason is that such a person would have expected that the combination to fail:*** (1) an antenna disposed on an IC would produce insufficient power to operate the IC; and (2) an on-chip component would be unable to store enough energy to power the chip. The proof is that every embodiment in the prior art used either a second, off-chip antenna or an external power source.

Incorrect Assertion Using Moskowitz

At the outset of his reply relating to the Moskowitz reference against claims 27 and 28, the Examiner states that for claim 27 “Moskowitz et al. teaches the known alternative use of first and

second separate dipole antenna for receiving and transmitting...”. This representation is incorrect in that *Moskowitz is not concerned with providing a tag comprising an integrated circuit that includes a first antenna, a signal receiving system, a separate power storage component, a data processing system and a second antenna.*

Furthermore, the Examiner points out that Moskowitz would teach the single antenna’s well known alternative of using separate transmitting and receiving antennas referring to Figures 4-6. While Moskowitz does disclose a single or two antennas and a battery externally connected to a chip, it does not show that an integrated circuit with built in first and second antenna with a power storage component. In fact, Moskowitz describes arranging the components of “...(chip and antenna and battery) in adjacent proximity to one another.”, but not as an integrated component as claimed in the present invention. (See Moskowitz, col. 4, lines 23-28).

The advantage of having the antennas on an integrated circuit is that while one of them receives the microwave signal from the interrogator which is used both to power the chip by storing charge onto a large on-chip capacitance bank and to transmit data to the chip, the second antenna is used to transmit the chip's response to any data requests from the interrogator. (See Spec, page 4, lines 16-20). Rather than using an active transmitter (which would require a large amount of power) for this purpose, this antenna is set up to reflect a continuous wave from the interrogator with varying efficiency; the data from the chip is encoded in the pattern of the efficiency variation which allows for the compactness of the tag. (See Spec, page 4, lines 20-24). Clearly, Moskowitz neither disclose nor suggest the present inventive subject matter.

Lack of Motivation And Improper Combination

With respect to the appellants previously presented arguments of improper combination of references, and lack of showing of any suggestion or motivation, the Examiner's reply is moot since reliance Kip et al, Moskowitz et al and Carroll is improper.

As a specific example, in rejecting claim 28, the Examiner provides a simple assertion that "...Kip et al., Moskowitz et al. and Carroll render all of the claimed subject matter obvious as in the consideration of amended claim 27". This assertion offers no further explanation or arguments as to why this is. ***This defect cannot be remedied by the mere reiteration of factually incorrect assertions.***

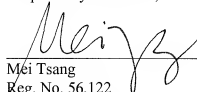
Dependent Claims Are Non-Obvious When Depending on Independent Claims

All other rejections were on dependent claims 33-52, 54-74, 76-84, 87 and 90-109, which are all dependent on claims 27, 28 and 75. Consequently, the same deficiencies as pointed out above therefore apply. If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Still further, the same arguments as presented in the appeal brief apply.

Conclusion Of Argument

In rejecting the presently pending claims, the Examiner respectfully fails to correctly identify each and every element of the claims. Furthermore, no reasoning was provided as to why the cited references would render the claims obvious. Even when the applicant ignored the lack of clarity, the combination of the references is improper as each of the references teach away, if not even against the claimed subject matter. Furthermore, and with particular reference to the independent claims 27, 28 and 75, the Examiner respectfully fails to provide any reason or argument as to why the claimed combination was suggested or motivated by the references or the knowledge of a person of ordinary skill in the art. The rejections thus should be withdrawn.

Respectfully submitted,



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Dated: September 19, 2006

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Tag Having a Semiconductor Chip and Method of Attachment to Article
Tumey Tumer

CLIENT/MATTER NO.: **101210.0001US1**

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Turney Turner

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